

Docket No.: 60154.301803

Patent

REMARKS

The Examiner is thanked for the comments in the Action. They have helped us considerably in understanding the Action and in drafting this Response thereto.

It is our understanding that claims 1-15 remain pending in this application.

Preliminary item:

An IDS was recently filed in this case. We regret having to do this so far along in prosecution. Since the present examiner also handled Applicant's two parent cases, he may appreciate this explanation. In an EPO case corresponding with Applicant's original parent application, WO 00/68868 A1 (Digital Castles) is now being argued. That art is for a data storage card that has a big spindle hole in the middle of it. So what we essentially have now is the EPO examiner making similar arguments to those the present Examiner made in Applicant's original parent application 09/835,961 (now Pat. No. 6,561,420), only there based on U.S. Pat. No. 6,011,677 by Rose. We have largely recycled the arguments that proved persuasive over Rose and submitted those to the EPO. While we fully expect those arguments to again be persuasive, we have filed the IDS because WO 00/68868 A1 (Digital Castles) is not of record in this series of cases. The other references in the IDS were ones also noted by the EPO.

We proceed now with reference specifically to the numbered items in the Action.

Item 1 (Acknowledgement of Terminal Disclaimer):

We thank the Examiner for noting this. Otherwise, it appears informational in nature and is understood to require no reply.

Item 2 (§ 103(a) rejections 1 of 6):

Claims 1, 8-11, and 15 are rejected as being unpatentable (obvious) over King in view of Foote and Desai. Respectfully this is error.

Before even turning to the arguments in the Action, we note that King is improper prior art. While the present application was filed on 09/13/2004 (after King was filed and published), it is a continuation-in-part of App. No. 09/835,961, filed April 10, 2001 (well before any relevant dates for King). Applicant's prior application encompassed all that King is relied upon for in support of the present rejection. See e.g., claim 6, which recited as originally filed "*the*

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information card having upon its said back surface at least one stripe zone and a ring zone suitable for containing magnetically recorded instances of the data” and which can now be seen with that very same language in Applicant’s U.S. Pat. No. 6,561,420.

Claims 1 and 9 are the independent claims in this case. Claim 1 recites three semi-colon demarcated limitations with respect to an information card and one with respect to a reader as a claimed system. Claim 9 recites three semi-colon demarcated limitations with respect to a claimed information card. King is relied on in the Action for teachings about information cards.

We urge that the rejection of claims 1 and 9 cannot be maintained without King and, in turn, that the rejections of claims 8, 10-11, and 15 also cannot be maintained, and that all of claims 1, 8-11, and 15 should now be allowed.

Arguendo, the Action further states that “*Foote teaches a stationary reader/read mechanism (col 1, lines 9+).*” Specifically, at col. 1, ln. 17-19 Foote states “*Alternately, means may be provided to move the read head while holding the card stationary. Such transport mechanisms are well known and many are commercially available.*” As is well known, however, rejections must be based on enabling teachings. In its “*BACKGROUND OF THE INVENTION*” section Foote is here merely stating a subjective and generalized opinion of the prior art – not an enabling teaching. This statement may be correct as a general proposition, yet be based on examples that could never be functionally combined with other art or that would ever meet the legal criteria for use in a valid rejection. As it stands now, Applicant has no reasonable opportunity to reply because has merely stated a conclusion without supporting details. Accordingly, Foote is either improper prior art or has yet to be properly argued in a manner amounting to valid prima facie 103 rejection.

The Action further states “*Desai teaches a card with printed matter on one side and stored data on the other (FIG. 2A+).*” Applicant agrees, but points out that Desai does not teach or reasonably suggest what King and Foote have been relied on for in the rejection. In essence, our point here is that the rejection fails to obtain because it does not properly address all of the elements of the claimed invention.

Item 3 (§ 103(a) rejections 2 of 6):

Claims 2, 4, and 12 are rejected as being unpatentable (obvious) over King in view of Foote and Desai, and further in view of Clark. Respectfully this is error.

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As a preliminary matter, without what King and Foote have been relied on for in support of the rejection, but fail to provide, and with there apparently being no argument in the Action that Desai or Clark somehow remedy this, we urge that the present rejection of claims 2, 4 and 12 also cannot be maintained, and that these claims should also be allowed.

Arguendo, the Action further states:

Clark teaches "It should be noted that, in the event the calling card utilized comprises a magnetic strip, it may not be necessary for the calling cardholder to dial the predetermined calling card service number or enter a calling card account number. Rather, in such instances, card reader 18 at originating phone 10 will read an encoded calling card service number and calling card account number from the magnetic strip on the calling card and automatically utilize such data to initiate a call to predetermined calling switch 22 (e.g., with the calling card account number being transmitted to switch 22 and manger 32 with such call)" (cot 5, lines 7+). This is interpreted to include the reader include a telephone device, and that the card includes data in the magnetic strip, where the data includes a phone number, and that the number is automatically dialed.

Since only claim 4 recites a telephone device or an equivalent, we presume that the above is intended to apply only to claim 4. However, claim 4 depends from claim 2, and we urge that Clark cannot be reconciled with the elements of claim 2. In fact, the Action next indirectly supports this, stating:

Though Clark is silent to the use of "data identifiers" at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to include data identifiers that evoke automatic responses when read, because it has already been taught above to automatically dial a phone in response to reading the card, and therefore having data identifiers would be an obvious expedient as a way to help organize/manage data that initiates automatic responses. Further, it is understood that a data identifier of some sort would necessarily be included so that the automatically dialing of a pre-stored service number could be completed by only swiping the card through the reader, as it is well known that data identifiers of cards are commonplace since they permit data such as the account number to be recorded/stored regarding a transaction.

And from this we reason that an apparent problem here is that "data identifier" is misunderstood. That term is defined in [Para 57] of the specification, and after review of that it should be clear to one of ordinary skill in the art that Applicant's data identifiers and what is in Clark are quite different.

We accordingly urge that the present rejection of claims 2, 4 and 12 also cannot be maintained and that these claims should also be allowed.

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Items 4-7 (§ 103(a) rejections 3, 4, 5, and 6 of 6):

Claim 3 is rejected as being unpatentable (obvious) over King in view of Foote, Desai, and Clark, and further in view of Vatanen; Claim 5 is rejected as being unpatentable (obvious) over King in view of Foote, Desai, and Clark, and further in view of Palomo; Claims 6 and 13 are rejected as being unpatentable (obvious) over King in view of Foote and Desai, and further in view of Kamo; and Claims 7 and 14 are rejected as being unpatentable (obvious) over King in view of Foote and Desai, and further in view of Marappan. Respectfully these are also error.

As a preliminary matter, we incorporate by reference our remarks about King/Foote/Desai/Clark from above, and urge that the rejections of these claims also cannot be maintained and that they should also no be allowed.

As regards the lengthy discussions in the Action about what it is felt that Vatanen, Palomo, Kamo, and Marappan teach, we urge that this is irrelevant because none teach enough of the claimed invention that we have any context within which to remark in a manner that will have relevance or further this prosecution. Simply put, with out the foundation of King and Foote, arguing these other references is pointless.

Items 8-10 (Response to Arguments, Conclusion, and closing comments):

These appear informational in nature and are understood to require no reply.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the §103 rejections have all been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,



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